

Amendment
Serial No. 10/527,800
Attorney Docket No. 052277

AMENDMENTS TO THE DRAWINGS

The attached replacement sheets of drawings include changes to Figs. 6 and 7.

REMARKS

Claims 3-10 are pending in the present application and are rejected.

Drawings

The Office Action maintains that Figures 6 and 7 should be designated by a legend such as “Prior Art.” The Office Action states that since Figures 6 and 7 are discussed in the background of the invention, they are prior art. Furthermore, the Office Action supports this position by noting that Figures 6 and 7 are described as “conventional” in the Brief Description of the Drawings. Although the application of MPEP §704.11(b)(I)(F) is not directly relevant (this section of the MPEP discusses when it is appropriate for an Examiner to make a Requirement for Information prior to a first action on the merits), it appears that the description of Figures 6 and 7 as “conventional” *may* be considered an admission as prior art.

According to MPEP §2129 (I), admissions by the applicant *may* constitute prior art. The relevant case law distinguishes between the “work of another” and the “work of the same inventive entity.” If identified as prior art, the “work of another” is available as prior art even if it fails to otherwise qualify as prior art under 35 U.S.C. §102. On the other hand, even if identified as prior art, the “work of the same inventive entity” is not available as prior art *unless* it qualifies as such under the statutory requirements.

Therefore, in response, Applicants herein confirm that the subject matter of Figures 6 and 7 is the work of the same inventive entity as the present invention. This is supported by the attached Declaration under 37 CFR 1.132 which states that the subject matter of Figures 6 and 7

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is the work of the inventors, Hikofumi Yamamoto and Yoshio Ihara. Based on this Declaration, Applicants respectfully submit that the subject matter of Figures 6 and 7 should not be applied as prior art for a rejection on the merits. However, Applicants herein comply with the requirement to designate the drawings with a legend. The attached replacement drawing sheet designates Figures 6 and 7 as "Related Art."

Applicants' Response to Claim Rejections under 35 U.S.C. §103

Claims 3, 5, 6, 8, 9 and 10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Figure 6 in view of JP-4114145 (JP '145).

It is the position of the Office Action that Figure 6 discloses the invention as claimed, with the exception of a through hole and much of the recited structure. The Office Action relies on JP '145 to provide these teachings. As discussed above, Applicants respectfully submit that Figure 6 should not be applied as prior art, even though it is labeled as "Related Art." Thus, since JP '145 does not disclose each and every limitation of the invention as claimed, Applicants respectfully request that the rejection be withdrawn.

However, even if Figure 6 were applied as prior art, the combination would not disclose the invention as claimed. In the response to the previous Office Action, Applicants stated that the previous rejection was based on the assumption that the Examiner relied on JP '145 to disclose the recited changes in thickness of the second attachment fitting 34. However, the present Office Action clarifies that JP '145 is *not* relied upon for these changes in thickness. Rather, the present Office Action states that "the thickness changing limitations are satisfied by

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Prior art figure 6 as illustrated in the annotated copy of Prior art figure 6 provided on pg. 3 of the instant Office action.”

Although this annotated Figure 6 accurately identifies a peripheral wall portion, a curved portion and a bottom wall portion, the Office Action provides no support for the position that Figure 6 discloses the recited differences in thickness. While the specification does not specifically state that the thicknesses of these three sections are equal, it appears that this is the case, based on the distinctions made in Figure 2 and the corresponding text. Additionally, according to MPEP §2125, “[w]hen the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value.” Accordingly, it is improper for the Office Action to rely on Figure 6 to teach the recited thicknesses without a disclosure in the specification to support this. Thus, the combination of Figure 6 and JP ‘145 does not disclose the invention as claimed.

With regard to claims 8 and 9, Applicants respectfully submit that these claims are patentable at least due to their dependency on claim 10, as discussed above. Furthermore, the Office Action maintains that *In re Jones* stands for the proposition that discovering the optimum or workable ranges involves only routine skill in the art. However, Applicants maintain that *In re Jones* actually discusses whether it was obvious to select one of six types of asbestos. In other words, *In re Jones* is applicable to whether it obvious to select a particular *species from a genus*, not whether it is obvious to provide for an optimum range. Additionally, Applicants note that the recited relationship between the recited dimensions relating to the bonding index imparts unexpected results of ensuring a sufficient strength when the serration bolt is press fitted and

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anchored to the aluminum-made second attachment fitting. Favorable reconsideration is respectfully requested.

Claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over Figure 6 in view of JP ‘145 and in further view of JP-2568225 (JP ‘225).

It is the position of the Office Action that the combination of Prior Art Figure 6 and JP ‘145 discloses the invention as claimed, with the exception of a sealing agent between the bolt and the second attachment fitting. The Office Action relies on JP ‘225 to provide this teaching.

In response, Applicants respectfully submit that claim 4 is patentable due to its dependency on claim 10, which Applicants submit is patentable for at least the reasons discussed above. Favorable reconsideration is respectfully requested.

Claim 7 was rejected under 35 U.S.C. §103(a) as being unpatentable over Figure 6 in view JP ‘145 and in further view of Krajewski (U.S. Patent No. 4,762,310).

The Office Action states that JP ‘079 was “applied to claim 5 above.” However, JP63-00079 (JP ‘079) was not relied upon anywhere in the pending Office Action, although it was relied upon in the previous Office Action. Further, claim 5 was rejected based only on Figure 6 and JP ‘145. It appears that the Office Action intended to rely upon a combination of Figure 6, JP ‘145, and Krajewski in this rejection, and the discussion below reflects this assumption.

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It is the position of the Office Action that Prior Art Figure 6 and JP '145 discloses the invention as claimed, with the exception of the lower end opening face being chamfered. The Office Action relies on Krajewski to provide this teaching.

First, Applicants respectfully submit that claim 7 is patentable due to its indirect dependency on claim 10. The Office Action states that "Figure 6, as modified, teach the use of a lower end opening face of the hole providing the non-serration bonding portion shown at the section within the hole in the bottom wall above section 102 of the bolt." Thus, the Office Action presumes that the majority of the portion of stud bolt 102 which is in female screw part 101 is a serration portion, which the lowermost portion is a non-serration portion. In response, Applicants herein clarify that Figure 6 does not include a serration portion. The portion of stud bolt 102 which is in female screw part 101 is not a serration portion, but rather a male screw portion. Accordingly, the combination of Figure 6, JP '145 and Krajewski does not disclose the invention as recited by claim 6.

With regard to claim 7, Applicants respectfully submit that even if the combination of Figure 6, JP '145 and Krajewski disclosed the recited non-serration portion as claimed, claim 7 is patentable due to its dependency on claim 10, as discussed above. Favorable reconsideration is respectfully requested.

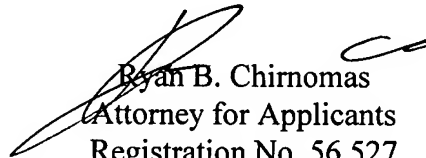
For at least the foregoing reasons, the claimed invention distinguishes over the cited art and defines patentable subject matter. Favorable reconsideration is earnestly solicited.

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Should the Examiner deem that any further action by applicants would be desirable to place the application in condition for allowance, the Examiner is encouraged to telephone applicants' undersigned attorney.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
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RBC/nrp

Enclosures: Declaration under 37 CFR 1.132
Replacement Drawing Sheet including changes to Figures 6 and 7



FIG. 6 RELATED ART

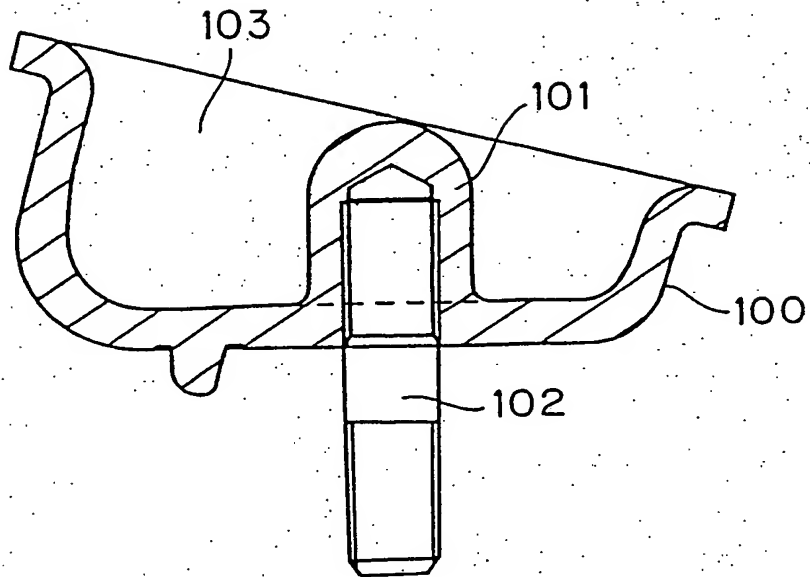
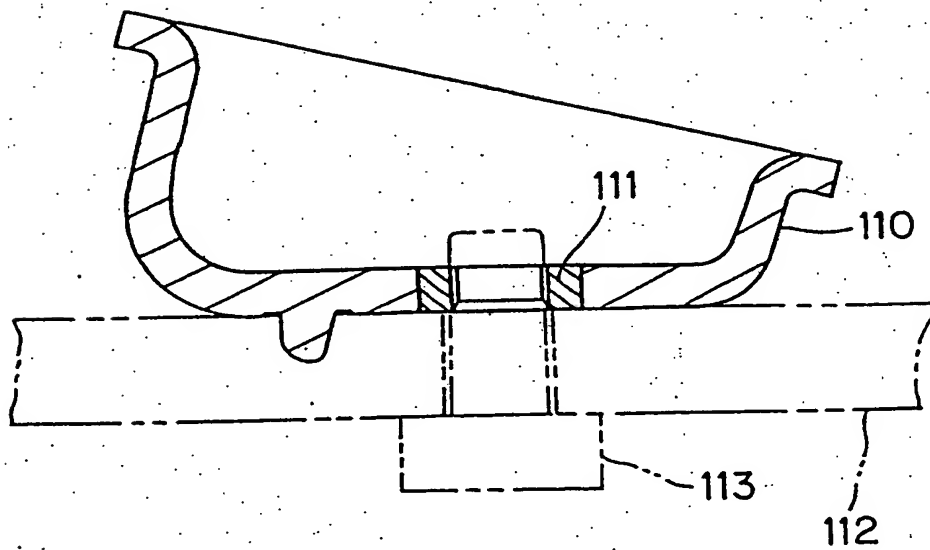


FIG. 7 RELATED ART





IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **Hikofumi YAMAMOTO et al.**

Group Art Unit: **3683**

Application Number: **10/527,800**

Examiner: **Melody M. Burch**

Filed: **March 15, 2005**

Confirmation Number: **9561**

For: **HYDRAULIC STYLE VIBRATION-PROOF DEVICE**

Attorney Docket Number: **052277**

Customer Number: **38834**

DECLARATION UNDER 37 C.F.R. §1.132

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I, Hikofumi YAMAMOTO, a citizen of Japan, hereby declare and state the following:

1. I graduated from Hosei University of Koganei-shi, Tokyo, Japan in 1999 with a master of engineering degree in mechanical engineering.

2. Since 1999, I have been employed by TOYO TIRE & RUBBER CO., LTD. of Osaka-shi, Osaka, Japan. During my employment therein, I have conducted research and development of engine mount.

3. I have read and am familiar with the above-identified patent application, including the Figures 6 and 7, as well as the Official Action dated January 17, 2007, in the application.

4. I hereby assert that the conceivable structures illustrated in Figures 6 and 7 are the work of the same inventive entity (Hikofumi Yamamoto and Yoshio Ihara) as the present invention. These drawings merely represent conceivable structures. Furthermore, these drawings do not represent publicly available material.



Declaration under 37 C.F.R. §1.132
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The undersigned declares that all statements made herein of his own knowledge are true, and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code and that willful false statements may jeopardize the validity of the application or any patent issued thereon.

Hikofumi Yamamoto
Hikofumi YAMAMOTO

Signed this 5 day of March, 2007.